

**REMARKS**

Claims 12 to 22 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to paragraph three (3) of the Office Action, claims 12, 13, 18, 19, 21, and 22 were rejected under 35 U.S.C. § 102(b) as anticipated by Hara et al., U.S. Patent No. 5,713,814.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the anticipation rejections may not be agreed with, to facilitate matters, claim 12, as presented, is to a “method for setting an operating point of a drive train,” which includes the feature of “*selecting a characteristic map from a plurality of characteristic maps on the basis of a required electrical power by an on-board electrical system.*”

The Hara reference does not identically disclose (or even suggest) the feature of selecting a characteristic map from a plurality of characteristic maps *on the basis of a required electrical power by an on-board electrical system*, as provided for in the context of claim 12, as presented.

The required electrical power of claim 12 cannot be compared to the state of charge of

the battery. As can be seen from paragraph [0023], the method according to the presently claimed subject matter takes into consideration the power required by the on-board electrical system. Thus, the required electrical power according to claim 12 is not the battery's state of charge but rather that of the on-board electrical system.

The Final office Action wrongly asserts that the maps in the present application are selected based on the battery's state of charge which is inversely proportional to the power required by the battery to achieve a full charge state. Taking the state of charge into consideration is an additional feature of dependent claim 13.

*By selecting a map based on the required electrical power of the on-board electrical system*, it is possible to set an operating point of the drive train such that electrical losses of the drive train during conversion of the drive train can be covered without charging or discharging the battery (see paragraph [0026]). In contrast, the Hara reference instead refers to switching the operation point due to the battery's state of charge. The method according to the presently claimed subject matter is therefore wholly different than that of Hara, which does not identically disclose (nor suggest) the feature of taking the required electrical power of the on-board electrical system into consideration, as provided for in the context of the presently claimed subject matter.

Still further, the Hara reference indicates switching modes "in accordance with the residue of the battery, as determined based upon the output of the battery residue detecting means." (Hara et al., col. 4, line 66, to col. 5, line 30). Further, Figures 14, 15, and 16 of the Hara reference merely indicate three mode switching maps, each corresponding to a particular battery residue, 60% to 85% residue, less than 60% residue, and greater than 85% residue, respectively. (Hara et al., col. 11, line 41, to col. 12, line 9). Thus, the Hara reference does not even refer to selecting a characteristic map on the basis of a required electrical power, but only to switching maps on the basis of the battery residue itself.

The Final Office Action states that the "battery state of charge [is] understood to be inversely proportional to the power required by the battery." *Final Office Action* at 2. It is, however, respectfully submitted that this is an incorrect assumption. Specifically, the battery residue is not necessarily inversely proportional to the required electrical power, since during the operation of a drive train, it is possible to have a low battery residue together with a low required electrical power, as well as a high battery residue together with a high required electrical power. Accordingly, the battery state of charge is not necessarily linked to the

power required by the battery, much less inversely proportional to the power required by the battery, as suggested by the Office Action.

To the extent the Final Office Action may be relying on the inherency doctrine, there must be provided a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art,” i.e. that the battery state of charge is understood to be inversely proportional to the power required by the battery. (M.P.E.P. § 2112). It is respectfully submitted that such a basis in fact and/or technical reasoning has not been provided in the Final Office Action. Further, the Final Office Action admits that the Hara reference “fails to teach the use of the electrical power required by consumers on the vehicle as governing the choice of characteristic map.” *Final Office Action* at 3. Therefore, it is plainly apparent that the system of the Hara reference only refers to switching maps on the basis of the battery residue, and does not identically disclose (or even suggest) the feature of selecting a characteristic map on the basis of a required electrical power of the on-board electrical system, as provided for in the context of claim 12, as presented.

Accordingly, it is respectfully submitted that claim 12, as presented, is allowable for at least the reasons provided above. Claims 13, 18, 19, 21, and 22 depend from claim 12, and are therefore allowable for at least the same reasons as claim 12.

Withdrawal of the rejections of these claims is therefore respectfully requested.

As to paragraph five (5) of the Final Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Hara reference.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the Hara reference does not disclose or even suggest all of the features of claim 12, so that it is allowable as is its dependent claim 20.

As to paragraph six (6) of the Office Action, claims 14 to 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over the Hara reference, in view of Yoshino et al., European Patent No. EP1142749.

As explained above, the Hara reference does not disclose or even suggest all of the features of claim 12, as presented. Since the Yoshino reference does not cure – and is not asserted to cure -- the critical deficiencies of the Hara reference, the proposed combination of the Hara reference and the Yoshino reference does not disclose or even suggest all of the features of claim 12, as presented, so that claim 12 is allowable, as are its dependent claims 14 to 17.

Withdrawal of the rejections of these claims is therefore respectfully requested.

In sum, it is respectfully submitted that claims 12 to 22 are allowable.

#### CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated:

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